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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,087	06/20/2003	Jotinderpal S. Sidhu	07K8-105445	8674

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EXAMINER	
VARGOT, MATHIEU D	
ART UNIT	**PAPER NUMBER**
1732	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/601,087	SIDHU ET AL.	
	Examiner	Art Unit	
	Mathieu D. Vargot	1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1.Claims 1-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims are rejected for reasons of record concerning the recitation of "without the application of pressure or vacuum to the insert", although applicant has shown support for the aspect of the insert not losing its structural integrity. However, the latter does not provide literal support for the former, since losing structural integrity merely means that the insert does not melt, not that it would not be reshaped. Applicant's comments have been noted but are not persuasive. Perhaps in certain situations the Board or courts have determined that negative limitations do not require literal support. However, this is certainly contrary to the general, quite well known edict that negative limitations require clear support and hence the rejection must stand.

2.Claims 2-6 and 14-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The independent claims 1 and 13 have been amended to recite that an irradiation source is provided and that such gives off radiant heat. However, radiant heat is generally known and considered to be IR—infrared—heat and would not be considered by one of ordinary skill to be microwave, UV or radio frequency. Hence, the "energy" of claims 2 and 14 should be –radiant heat--; the infrared energy of claims 3 and 15 would

already be inherent in claims 1 and 13 and hence these claims would fail to further limit; and claims 6 and 18 would be indefinite in reciting heating methods which would not be typically considered to be radiant heating methods.

3.The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhalakia et al (see col. 18, lines 12-67) in view of Uchiyama et al (see 5 in Fig. 2) , either alone, or further in view of Hirmer et al (col. 7, lines 53-55).

Bhalakia et al and Hirmer et al are applied for reasons of record, the references disclosing the basic claimed invention lacking essentially the aspect of providing an irradiation source separate from the mold cavity and heat-soaking the insert part via radiant heat from the source. Newly applied Uchiyama et al shows a heater that provides radiant heat to a film/insert that is subsequently placed in an injection mold and material injected thereagainst to form a composite product. It is believed that one of ordinary skill in the art would realize that an insert would be heated with an external source, as shown in Uchiyama et al, as easily as being heated on a mold as taught in Bhalakia et al. The two methods would clearly be equivalents of each other and the selection of either would have been an obvious choice dependent on heating equipment available.

4.Applicant's arguments filed October 25, 2006 have been fully considered but they are not persuasive. Applicant's comments with respect to the new matter rejection have already been addressed. While there may indeed be certain instances when literal support was deemed to be unnecessary for a negative limitation, it is respectfully submitted that a conclusion of this nature would have to come from the Board or a court decision. Until such occurs, the rejection must stand. As applicant should be aware, an examiner does not have the authority to allow language to be inserted into claims when there is no support for this language in the specification as originally filed. Again, heat alone is not necessarily the only way the instant insert would be pre-conditioned, as the instant specification is not so limited.

5.**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6.Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson, can be reached on 571 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
January 5, 2007

M. Vargot

Mathieu D. Vargot
Primary Examiner
Art Unit 1732

1/5/07